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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte JEFF STEWART and JENNIFER R. PINCO

Appeal 2007-3345
Application 09/709,433
Technology Center 2100

Decided: June 16, 2008

Before LANCE LEONARD BARRY, ALLEN R. MACDONALD, and
ST. JOHN COURTENAY III, *Administrative Patent Judges*.

COURTENAY, *Administrative Patent Judge*.

DECISION ON APPEAL

This is a decision on appeal under 35 U.S.C. § 134(a) from the Examiner's rejection of claims 12-33. Claims 1-11 have been cancelled (App. Br. 2). We have jurisdiction under 35 U.S.C. § 6(b).

We AFFIRM.

THE INVENTION

The disclosed invention relates generally to a system, method and recordable medium for uploading data across a network. More particularly, Appellants' invention is directed to uploading a document across the network for printing services, and configuring, ordering, and viewing the document online (Spec. 1).

Independent claim 12 is illustrative:

12. A method of previewing a document over a network, the method comprising:
 - providing system software for use on a client, wherein the system software allows a user of the client to generate a print file on the client based on the document using a local application;
 - obtaining the print file from the client on a server;
 - obtaining configuration information for the document on the server;
 - generating a preview of a configured copy of the document on the server based on the print file and the configuration information; and
 - providing the preview for display at the client.

THE REFERENCES

The Examiner relies upon the following references as evidence in support of the rejections:

Adamske	US 6,615,234 B1	Sep. 2, 2003
Bresnan	US 5,873,073	Feb. 16, 1999

THE REJECTIONS

Claims 12-27 and 29-33 stand rejected under 35 U.S.C. §103(a) as being unpatentable over Adamske.

Claim 28 stands rejected under 35 U.S.C. §103(a) as being unpatentable over Adamske in view of Bresnan.

PRINCIPLES OF LAW

Obviousness under 35 U.S.C. § 103

“What matters is the objective reach of the claim. If the claim extends to what is obvious, it is invalid under § 103.” *KSR Int’l Co. v. Teleflex, Inc.*, 127 S. Ct. 1727, 1742 (2007). To be nonobvious, an improvement must be “more than the predictable use of prior art elements according to their established functions.” *Id.* at 1740. Appellants have the burden on appeal to the Board to demonstrate error in the Examiner’s position. *See In re Kahn*, 441 F.3d 977, 985-86 (Fed. Cir. 2006) (“On appeal to the Board, an applicant can overcome a rejection [under § 103] by showing insufficient evidence of *prima facie* obviousness or by rebutting the *prima facie* case with evidence of secondary indicia of nonobviousness.”) (quoting *In re Rouffet*, 149 F.3d 1350, 1355 (Fed. Cir. 1998)). Therefore, we look to Appellants’ Briefs to show error in the proffered *prima facie* case.

Rationale for Modification of Adamske

The Examiner has rejected all but claim 28 under 35 U.S.C. § 103 using a single reference (Adamske). The Examiner proffers that an artisan

would have been motivated to combine or otherwise modify alternate embodiments disclosed in Adamske, as follows:

Adamske does not directly disclose in this embodiment that a preview is generated by the server and provided to the user based on the print file that was uploaded. However, Adamske discloses an alternate method in which the server generates a preview based on the print file and the configuration information and provides that preview to the user for display at the client device (column 5, line 64- column 7, line 15 of Adamske). It would have been obvious to one of ordinary skill in the art to combine the two methods of Adamske because it would have allowed the client system to do less work in the process.

(Ans. 3).

In response, Appellants contend that the Examiner has improperly relied upon hindsight, as follows:

Adamske provides two embodiments for network-based document delivery. The Examiner primarily relies on the second embodiment in which the client performs some of the processing, e.g., generates a metafile and print preview. Adamske, col. 6, lines 24-57. The Examiner proposes to modify this embodiment with teachings of the first embodiment in which the client sends an electronic document to a server and displays a preview in a browser. Adamske, col. 4, line 61 -col. 6, line 23. The Examiner's motivation for the modifications is to "reduce the processing load at the client." Final Office Action, p. 12.

However, the first embodiment of Adamske (col. 4, line 61-col. 6, line 23) provides a solution in which the processing load at the client is reduced from that in the second embodiment. As a result, by its express teachings, Adamske has already addressed the motivation cited by the Examiner and teaches away from the Examiner's proposed modifications

and Appellants' claimed invention. Since proper motivation is not found in Adamske, Appellants respectfully submit that the Examiner fails to show that Adamske or the prior art provides proper motivation for the modifications proposed by the Examiner without using the hindsight of the present invention. (App. Br. 16-17).

After considering the record before us, it is our view that an artisan would have perceived the two embodiments relied on by the Examiner as being complements of each other. Courts should “take account of the inferences and creative steps that a person of ordinary skill in the art would employ.” KSR, 127 S. Ct. at 1741. Therefore, it is our view that the teachings of Adamske would have at least suggested the claimed variation to an artisan having ordinary skill and creativity. Moreover, “[t]he combination of familiar elements according to known methods is likely to be obvious when it does no more than yield predictable results.” *Leapfrog Enter., Inc. v. Fisher-Price, Inc.*, 485 F.3d 1157, 1161 (Fed. Cir. 2007) (quoting KSR, 127 S. Ct. at 1739).

This reasoning is applicable here. The Examiner has merely rearranged familiar elements taught by Adamske, such as a client, a server, and a print file having associated configuration information (e.g., fonts). It is our view that the Examiner’s proffered combination of such familiar elements would have yielded predictable results. Appellants have not rebutted the Examiner’s legal conclusion of obviousness by showing that the claimed combination of familiar elements produces any new function. Moreover, Appellants have not provided any factual evidence of secondary considerations, such as unexpected or unpredictable results, commercial success, or long felt but unmet need. Accordingly, we find Appellants’

arguments unpersuasive that the Examiner has relied upon impermissible hindsight in modifying Adamske. We also note that Appellants do not challenge the Examiner's proposed combination of Adamske and Bresnan with respect to independent claim 28 (*see* App. Br. 20).

FINDINGS OF FACT

The following findings of fact (FF) are supported by at least a preponderance of the evidence:

1. Adamske teaches that “web server 22 can include a print preview software program 16 . . .” (Col. 6, ll. 4-5). Regarding Appellants’ claimed “print file,” Adamske teaches that “[a]pplication translation server 24 includes a conversion program 18 that is executable to read in the electronic document and convert the document to a portable printable format [print file].” (Col. 5, ll. 20-24). In one embodiment, Adamske teaches that the print file may be a PostScript format file. (Col. 5, ll. 65-66). Regarding Appellants’ claimed “configuration information,” Adamske teaches that font database 31 (Fig. 2) is used to facilitate the conversion. (Col. 5, ll. 46-47). Adamske clearly uses font database 31 (i.e., configuration information) to generate the preview print file.
2. Adamske teaches a shipping label (i.e., memo information) (col. 7, l. 42). Adamske teaches that “[t]he hard copy document is . . . packaged according to the user preferences defined at operational screen 70 and delivered to the user-designated

recipient(s). Optionally, the print job that produces the hard copy document can also include a print out of the packaging instructions selected by the user, a cover sheet, and a shipping label (if applicable).” (Col. 7, ll. 37-43).

3. Adamske teaches a conversion program 18 (i.e., system software) (Col. 5, ll. 21-22). Adamske teaches that “[a]pplication translation server 24 includes a conversion program 18 [i.e., system software] that is executable to read in the electronic document and convert the document to a portable printable format.” (Col. 5, ll. 21-24).
4. Adamske teaches that “[p]rint management server 28 will retrieve the converted printable (PostScript) electronic document and will send the document to the particular remote print spooler server 30 having the ID included at web server 22 via network 12. Network 12 can be the Internet or a private network connection for high traffic destinations such as an airborne courier. The print spooler server 30 prints the document at printer 40 attached locally to print spooler server 30.” (Col. 7, ll. 27-35).
5. Adamske teaches a web browser (i.e., user interface) (Col. 5, l. 15).

ANALYSIS

After reviewing the record before us, we address arguments presented in the Briefs only to the extent that Appellant's arguments are directed to claimed subject matter. Patentability is based upon the claims. "It is the claims that measure the invention." *SRI Int'l v. Matsushita Elec. Corp. of America*, 775 F.2d 1107, 1121 (Fed. Cir. 1985) (*en banc*). "Moreover, limitations are not to be read into the claims from the specification." *In re Van Geuns*, 988 F.2d 1181, 1184 (Fed. Cir. 1993) (citing *In re Zletz*, 893 F.2d 319, 321 (Fed. Cir. 1989)).

We consider the following issues that flow from the contentions of the Appellants and the Examiner:

Independent claim 12

We disagree with Appellants' contention that Adamske fails to teach the claimed generation of a preview based on anything other than a converted printable electronic document (*see* App. Br. 8, ¶1). To the contrary, we find Adamske clearly uses font database 31 (i.e., configuration information) to generate the preview print file. Therefore, we find that Adamske teaches generating a preview of a configured copy of the document on the server based on the print file and the configuration information, as claimed (*see* FF 1, *supra*). Because we conclude that Appellants have not shown the Examiner erred, we sustain the Examiner's rejection of independent claim 12 as being unpatentable over Adamske.

Independent claim 17

Appellants contend that Adamske fails to teach obtaining memo information that is customized for a recipient at each of a plurality of delivery addresses, let alone printing and delivering the customized memo along with the one or more copies of the document to each of the delivery addresses (App. Br. 9-10). In response, we broadly but reasonably construe the scope of the claimed “memo” as encompassing a shipping label that is customized according to the recipient’s name and address and delivered with the print job, as taught by Adamske. See FF 2, *supra*. Therefore, we find that Adamske teaches obtaining memo information (i.e., a shipping label) that is customized for a recipient at each of a plurality of delivery addresses, and printing and delivering the customized memo along with the one or more copies of the document to each of the delivery addresses, as claimed. Because we conclude that Appellants have not shown the Examiner erred, we sustain the Examiner’s rejection of independent claim 17 as being unpatentable over Adamske.

Independent claim 20

Regarding independent claim 20, we have fully addressed the “generating” limitations in our discussion of independent claim 12 *supra*.

Appellants further argue that “[i]n both embodiments discussed in Adamske, a printable version of the electronic document is expressly generated on an application translation server (e.g., col. 5, lines 18-19, 64- 66 and col. 6, lines 49-52) rather than by system software on a client as in the claimed invention.” (App. Br. 13).

In response, we broadly but reasonably construe a “client” as a requester of services and a “server” as a provider of services. To the extent that a client generates a print file and communicates the print file to a server, the client is providing a service (i.e., the print file) to the server. In this context, the client has become a server and the server has become a client. We restate our view that an artisan would have perceived the two embodiments disclosed by Adamske as being complements of each other. The person of ordinary skill is a person of creativity. Courts should “take account of the inferences and creative steps that a person of ordinary skill in the art would employ.” KSR, 127 S. Ct. at 1741. Therefore, it is our view that the teachings of Adamske would have at least suggested the claimed variation to an artisan having ordinary skill and creativity.

Regarding the claimed “system software” element, we broadly but reasonably construe the scope of this term as encompassing any utility software associated with a computer system, noting that any program or utility can be included or associated with an operating system as a matter of design. Therefore, it is our view that Adamske’s conversion program 18 teaches and/or suggests “system software,” as claimed. See FF 3, *supra*. Because we conclude that Appellants have not shown the Examiner erred, we sustain the Examiner’s rejection of independent claim 20 as being unpatentable over Adamske.

Independent claim 24

We have fully addressed the “generating” limitations argued by Appellants in our discussion of independent claim 12 *supra*.

In our response for independent claim 20 we fully addressed Appellants contention that Adamske fails to teach or suggest means for obtaining a print file from a client. Again, it is our view that the teachings of Adamske would have at least suggested the claimed variation to an artisan having ordinary skill and creativity, as previously discussed.

Regarding Appellants contention that the Examiner fails to show that Adamske teaches or suggests the claimed means for assembling a copy based on configuration information, we broadly but reasonably construe the claim term “based on” as meaning “any association with.” (*See App. Br.* 18). We note that Adamske’s preview and printed copy both include fonts (i.e., configuration information). Therefore, it is our view that assembling a printed copy is reasonably “based on” fonts, because each printed page includes fonts.

Because we conclude that Appellants have not shown the Examiner erred, we sustain the Examiner’s rejection of independent claim 24 as being unpatentable over Adamske.

Independent claim 29

We have fully addressed the “generating” limitations argued by Appellants in our discussion of independent claim 12 *supra*.

In our response for independent claim 20 we fully addressed Appellants contention that Adamske fails to teach or suggest means for

obtaining a print file from a client. Again, it is our view that the teachings of Adamske would have at least suggested the claimed variation to an artisan having ordinary skill and creativity, as previously discussed.

Because we conclude that Appellants have not shown the Examiner erred, we sustain the Examiner's rejection of independent claim 29 as being unpatentable over Adamske.

Independent claim 31

We have fully addressed the "memo" limitations in our discussion of independent claim 12 *supra*.

It is our view that Adamske teaches the claimed "program code for obtaining a print file and configuration information communicated over a network, wherein the print file is based on the document and the print file can be directly printed by a printer" (claim 31). See FF 4, *supra*.

Because we conclude that Appellants have not shown the Examiner erred, we sustain the Examiner's rejection of independent claim 31 as being unpatentable over Adamske.

Independent claim 28

Regarding independent claim 28, we have fully addressed the "generating" limitations in our discussion of independent claim 12 *supra*. It is our view that Adamske teaches and/or suggests a user interface, as claimed. See FF 5, *supra*.

Regarding the Examiner's reliance on style options as teaching the claimed configuration information, it is our view that the claimed configuration information broadly but reasonably encompasses Adamske's fonts as contained in font database 31 (col. 5, ll. 47, Fig. 2). See FF1 and FF 4, *supra*. Clearly fonts can be altered (i.e., resized) using a "standard web browser," such as that disclosed by Adamske (col. 6, ll. 21-22). Therefore, we find that Adamske's web browser provides a user interface (i.e., configuration area) that enables the user to alter configuration information (i.e., fonts) in addition to previewing documents for printing (*see* Adamske, col. 6, ll. 20-22). See FF5, *supra*.

While our reading of Appellants' claims on the Adamske reference may have departed from some aspects of the Examiner's reading, it is our view that Appellants have been given full and fair notice of the Adamske reference and are responsible for all it discloses. *See In re Zenitz*, 333 F.2d 924, 926 (CCPA 1964) ("This court has held in a number of decisions that a United States patent speaks for all it discloses as of its filing date, even when used in combination with other references.")

Because we conclude that Appellants have not shown the Examiner erred, we sustain the Examiner's rejection of independent claim 28 as being unpatentable over Adamske in view of Bresnan.

Dependent claims 13-16, 18, 19, 21-23, 25-27, 30, 32, and 33

These dependent claims were not separately argued in the Briefs. Therefore, we sustain the Examiner's rejection of these claims as being unpatentable over Adamske for the same reasons discussed *supra* with

respect to representative independent claims 12, 17, 20, 24, and 29, respectively. *See* 37 C.F.R. § 41.37(c)(1)(vii).

CONCLUSION OF LAW

From the above discussion, we conclude that Appellant has not sustained the requisite burden on appeal in providing arguments or evidence persuasive of error in the Examiner's rejections. Section 103 within Title 35 of the U.S. Code "forbids issuance of a patent when 'the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains.'" *KSR*, 127 S. Ct. at 1734 (quoting 35 U.S.C. § 103). Based on the findings of facts and analysis above, we conclude that Appellants have not met their burden of showing that the Examiner erred in rejecting claims 12-33 under 35 U.S.C. § 103(a) for obviousness.

Appeal 2007-3345
Application 09/709,433

DECISION

We affirm the Examiner's decision rejecting claims 12-33.

No time period for taking any subsequent action in connection with this appeal may be extended under 37 C.F.R. § 1.136(a)(1)(iv).

AFFIRMED

pgc

HOFFMAN WARNICK LLC
75 STATE STREET
14TH FLOOR
ALBANY NY 12207